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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,288	10/01/2003	Randal T. Byrum	END5085-0515150	7075

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EXAMINER

MENDOZA, MICHAEL G

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/676.288

Applicant(s)

BYRUM ET AL.

Examiner

Michael G. Mendoza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-13 and 15-32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-13, 15-20 and 29-32 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-9, 21, 22 and 24-27 is/are rejected.
- 7) ☐ Claim(s) 23 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10 January 2006 have been fully considered but they are not persuasive.
2. As to claim 1, the applicant argues that Hart et al. doesn't not teach a mechanism for releasably engaging a gastric band. The applicant does not positively claim a gastric band. The claim does not identify any structural limitations associated with the mechanism. In Fig. 5 and 6 the distal end 46 of part 42 can be called a mechanism for releasably engaging a gastric band. Simply touching distal end 46 to a gastric band and then pulling the distal end 46 away from the band would read on the limitation. The gastric band is not positively claimed and releasably engaging a gastric band is functional language.
3. As to claim 21, the applicant argues that Antebi does not disclose an open distal end sized to encompass an adjustable gastric band. As can be seen in Fig. 4 of Antebi the support tube has an opening. The elongated inner rod is smaller than the opening and is able to fit through the opening. The band of Antebi is smaller than the elongated inner rod as seen in Fig. 4. Since the band of Antebi is smaller than the elongated inner rod, at least a portion of the band would be able to pass through the opening. Therefore the opening at the distal end of the support tube of Antebi is sized to encompass a gastric band. The claim does not include any limitation that the band is actually surrounded or encompassed by the support tube. As to the newly added limitation of "said rod being slidable from a proximal position, wherein the shelf is retained in the

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elongated support tube, to a distal position, wherein said rod exposed at least a portion of said shelf", Antebi is fully capable of being placed in the claimed configuration by moving the elongated inner rod back and forth through the support tube.

4. As to claim 24, in response to applicant's argument that the band is a gastric band, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The applicant also argues that distal movement of the rod exposed the gastric band. The claim does not state what the gastric band is being exposed to or from. The examiner disagrees with the applicant's argument. The distal movement of the inner rod of Antebi would expose the band closer to a surgical site.

5. Applicant's arguments, see 14-15, filed 15 December 2005, with respect to claims 29 and 30 have been fully considered and are persuasive. The 35 USC 102(b) rejections of claims 29 and 30 have been withdrawn. The examiner agrees that Antebi fails to teach wherein the adjustable gastric band is in the elongated support tube.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 1-3, 5, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hart et al.

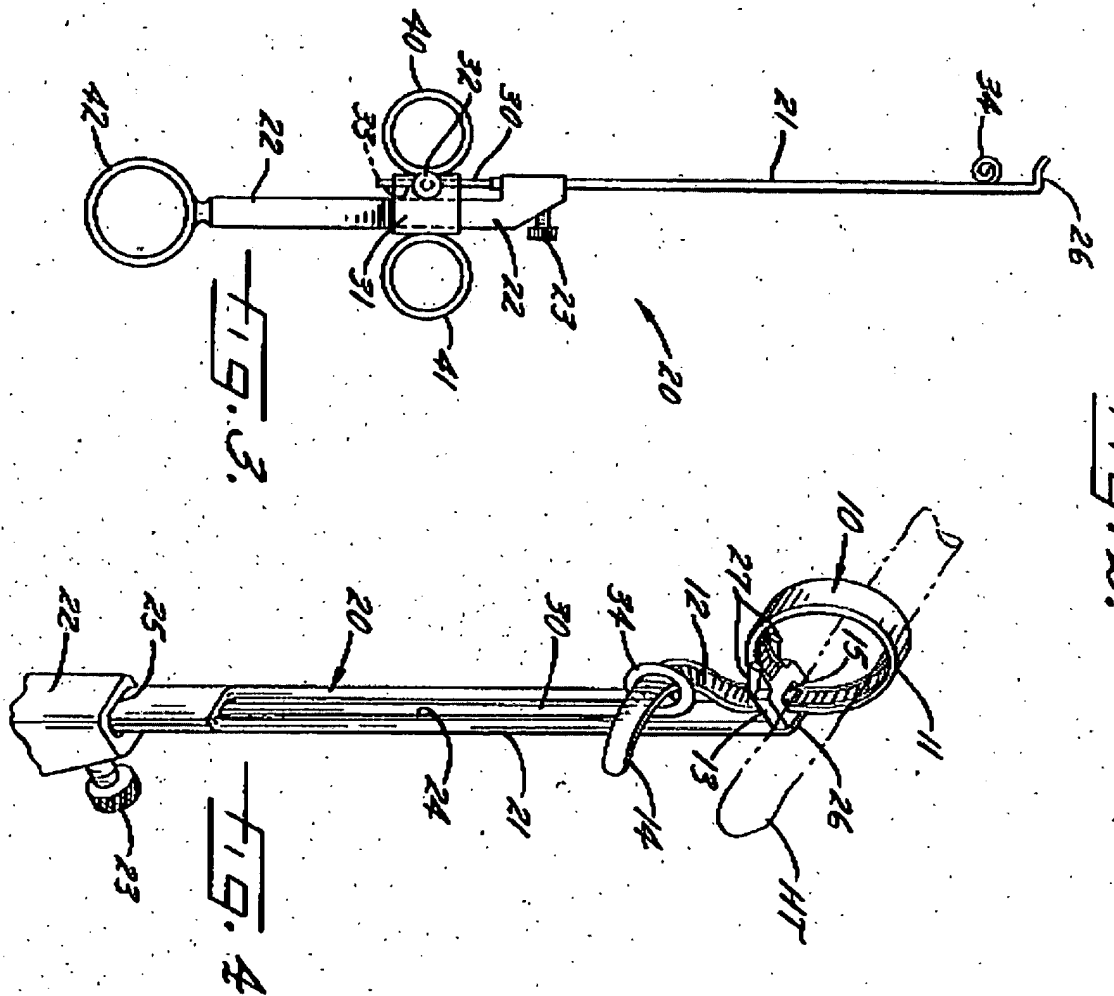
8. Hart et al. teaches a surgical instrument comprising : an elongated support tube having a proximal end, a distal end and an inner surface having a longitudinal groove (22L + 22R) therein, an elongated inner rod 42 having a proximal end, a distal end and a longitudinal protrusion 52; wherein the distal end comprises a mechanism capable of releasably engaging a gastric band; wherein the inner rod is slidably and coaxially disposed with the support tube wherein the longitudinal protrusion of the elongated inner rod is slidably engaged with the longitudinal groove of the inner surface of the elongated support tube and wherein the distal movement of the rod exposes the mechanism capable of engaging a gastric band (col. 5, lines 57-62); wherein the proximal end of the elongated rod includes a thumb ring (fig. 1); wherein the mechanism for releasably engaging a gastric band includes one or more pins 240; wherein the proximal end of the elongated support tube includes a handle (fig. 1).

9. Claims 21, 22, and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Antebi 4592355.

10. Antebi teaches a surgical instrument comprising: an elongated support tube having a proximal end and a distal end; an elongated inner rod having a proximal end and a distal end wherein the distal end comprises a shelf, the shelf having one or more pins disposed thereon; wherein the inner rod is slidably and coaxially disposed within the support tube and wherein the distal movement of the rod exposes the shelf; a

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gastric ban releasably secured to the shelf; wherein the proximal end of the elongated rod includes a thumb ring.



Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hart et al.

13. Hart et al. discloses the claimed invention except for the range for the lengths and diameters. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the claimed ranges, since it has been held that wherein the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Allowable Subject Matter

14. Claims 10-13, 15-20, 29-32 are allowable over the prior art of record.

15. Claims 23 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach or render obvious the overall claimed invention of a surgical system comprising: an elongated support tube having a proximal end, a distal end and an inner surface having a longitudinal groove therein; an elongated inner rod having a proximal end, a distal end and a longitudinal protrusion wherein the inner rod is slidably and coaxially disposed within the support tube wherein the longitudinal protrusion is slidably engaged with the longitudinal groove of the inner surface of the elongated support tube; and a gastric band releasably secured to the

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distal end of the inner rod wherein the distal movement of the rod exposes the gastric band, or wherein the gastric band is retained in the elongated support tube.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Mendoza whose telephone number is (571) 272-4698. The examiner can normally be reached on Mon.-Fri. 8:00 a.m. - 5:00 p.m..


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-44963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MM


GLENN K. DAWSON
PRIMARY EXAMINER